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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/749,174	12/27/2000	Liisa Kanninen	557.302US01	4935

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EXAMINER

WORJLOH, JALATEE

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 12/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/749,174

Applicant(s)

KANNIAINEN, LIISA

Examiner

Jalatee Worjloh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 41-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-40 have been examined.

Election/Restrictions

2. Claims 41-50 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in Paper No. 8.

3. Applicant's election with traverse of Invention I in Paper #8 is acknowledged. The traversal is on the grounds that the "examiner has not made the showing required by M.P.E.P. § 806.05(d)". However, Applicant's argument is not persuasive; that is, the examiner believes that the restriction is proper since the subcombinations are distinct, each from the other, and are shown to be separately usable. Invention II (claims 41-50) has separate utility such as validating the signature by the trusted system and sending the signed contract to the merchant system, which is classified as 705/76; whereas, Invention I is classified as 705/80. Thus, the examiner notes that it would be a serious burden to search both inventions given their separate status in the art as noted above.

The requirement is still deemed proper and is therefore made **FINAL**.

Applicant has provisionally elected Group I (claims 1-40); consequently, an examination of the merits of these claims is included below.

Specification

4. The disclosure is objected to because of the following informalities: typographically error: change “at” to “an” (see pg. 1, line 18) and change “inlcudes” to ‘include” (see pg. 9, line 5).

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 3, 7, 8 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
7. Claim 3 recites the limitation "the content source" in lines 1 and 2. There is insufficient antecedent basis for this limitation in the claim.
8. Claim 7 recites the limitation "the content source" in line 1. There is insufficient antecedent basis for this limitation in the claim.
9. Claim 8 recites the limitation "the content" in line 1. There is insufficient antecedent basis for this limitation in the claim.
10. Claim 12 recites the limitation "the mobile system" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1-7, 9-14, 21-26, 33-35, and 37-40 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 2002/0038292 to Quelene.

Referring to claims 1 and 22, Quelene discloses a trusted server, the trusted server prepares a contract for a transaction between a merchant system and a buyer system, sends the prepared contract to the buyer system for acceptance by a user of the buyer system and return the accepted contract to the merchant system wherein the merchant system initiates the transaction based upon the accepted contract and a charging engine for calculating a charge to be paid to the merchant system by the user (see paragraphs [0018] and [0019]).

Referring to claims 2 and 37, Quelene discloses the merchant system identifies whether the trusted server can modify the contract (see paragraphs [0017]).

Referring to claims 3, 4 and 33, Quelene discloses the trusted server finalizes the content source (see paragraphs [0023]).

Referring to claims 5 and 24, Quelene discloses an interface between the merchant system and the buyer system, the interface including a Wireless Application Protocol (WAP)

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server for the buyer system supporting WAP connection (see paragraphs [0035]). Notice, Quelene indicates that “the purchaser programs are more likely to be personal computers, handheld computers, television set-top boxes...”, which suggest that the interface may include a WAP server for WAP connection. Also, it is known in the art that WAP allow users to access information via handheld devices; thus, interface including a WAP server is clearly taught by Quelene.

Referring to claims 6 and 34, Quelene discloses the product further comprises at least a portion of a content source (see paragraph [0023]).

Referring to claims 7 and 35, Quelene discloses a content source comprises a document (see claims 25 and 26).

Referring to claims 9,10, 38 and 39, Quelene discloses the buyer system comprises a mobile terminal, i.e. “handheld computers”; wherein the mobile terminal comprises a web-enabled mobile phone (see paragraph [0035]). Notice, Quelene indicates that “the purchaser programs are more likely to be personal computers, handheld computers, television set-top boxes...”, which suggest that the mobile terminal may comprise a web-enabled mobile phone.

Referring to claims 11 and 40, Quelene discloses the buyer system comprises a computer system coupled to the Internet.

Referring to claims 12 and 23, Quelene discloses a World Wide Web interface, the World Wide Web interface interfacing the buyer system and a mobile system (see abstract).

Referring to claims 13 and 25, Quelene discloses the trusted server receives payment from the buyer system, confirms payment by the buyer system (see paragraphs [148]-[153]) and

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prevents non-repudiation of the transaction by the buyer system (see paragraph [0057] and [0093]).

Referring to claims 14 and 26, Quelene discloses the charging engine receives charging data representing billing information from the merchant system and transfers a charge amount to the buyer system for payment by the buyer system (see paragraphs [0039] and [0040]).

Referring to claim 21, Quelene discloses at least one buyer system for operation by a user desiring to purchase a product, at least one merchant system configured for providing a user a product and at least one payment system, wherein the payment system handles the negotiation of a contract for a transaction between the merchant system and the buyer system concerning the product (see paragraphs [0015], [0017] and [0033]).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 8 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quelene as applied to claims 5 and 34 respectively above.

Quelene discloses a content source (see claims 25 and 26). Quelene does not expressly disclose the content comprises a multimedia object. However, this difference is only found in the nonfunctional descriptive material and is not functionally involved in the step recited. The server prepare a contract and return the accepted contract regardless of the content type (e.g. multimedia object). Thus, this descriptive material will not distinguish the claimed invention

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from the prior art in term of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *in re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to prepare a contract and return the accepted contract regardless of the content type because the content type does not functionally relate to the steps in the method claimed.

15. Claims 15, 16, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quelene as applied to claims 14 and 26 respectively above, and further in view of U.S. Pub. No. 2003/0078862 to Kojima et al.

Referring to claims 15 and 27 Quelene discloses a charging engine (see paragraphs [0039] and [0040]). Quelene does not expressly disclose the charging engine converts the received charging data into another form ready to be transferred to the buyer system. Kojima et al. disclose the charging engine converts the received charging data into another form ready to be transferred to the buyer system (see paragraph [0122]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the charging engine disclosed by Quelene to convert the received charging data into another form ready to be transferred to the buyer system. One of ordinary skill in the art would have been motivated to do this because doing so “ensures the production of data”; thus, securing the charging data and preventing fraud.

Referring to claims 16 and 28, Quelene discloses a trusted server (see claim 14 above). Quelene does not expressly disclose the trusted server receives payment from the buyer system based upon the charge amount sent to the buyer system, confirms payment by the buyer system and signals the merchant system. Kojima et al. disclose the trusted server receives payment from

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the buyer system based upon the charge amount sent to the buyer system, confirms payment by the buyer system and signals the merchant system (see paragraph [0008]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Quelene to include the trusted server receives payment from the buyer system based upon the charge amount sent to the buyer system, confirms payment by the buyer system and signals the merchant system. One of ordinary skill in the art would have been motivated to do this because provides an indication that the merchant will receive payment for the service provided.

16. Claims 17-19 and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quelene as applied to claim 1 and 22 respectively above, and further in view of Kojima et al.

Quelene discloses a trusted server (see claims 1 and 22 above). Quelene does not expressly disclose the trusted server provides authentication for the transaction to the buyer, the merchant system or authentication for the transaction comprises authentication of the product. Kojima et al. disclose the trusted server provides authentication for the transaction to the buyer, the merchant system (see paragraph [0123] and authentication for the transaction comprises authentication of the product (see paragraph [0100]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Quelene to include the trusted server provides authentication for the transaction to the buyer, the merchant system or authentication for the transaction comprises authentication of the product. One of ordinary skill in the art would have been motivated to do this because it provides security; thus preventing fraudulent activities.

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17. Claim 20 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quelene as applied to claim 1 and 21 respectively above, and further in view of US Pub. No. US 2002/0107785 to Melchior et al.

Quelene discloses a buyer system, financial system and merchant system (see claim 1 above). Quelene does not expressly disclose a financial compensation system, the financial compensation system providing financial transaction support to the buyer system and the merchant system for the transaction. Melchior et al. disclose a financial compensation system, the financial compensation system providing financial transaction support to the buyer system and the merchant system for the transaction (see paragraph [0009]. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Quelene to include a financial compensation system, the financial compensation system providing financial transaction support to the buyer system and the merchant system for the transaction. One of ordinary skill in the art would have been motivated to this because it doing will provide sufficient customer service to the buyer and merchant.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 703-305-0057. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306, 703-746-9443 for Non-Official/Draft.

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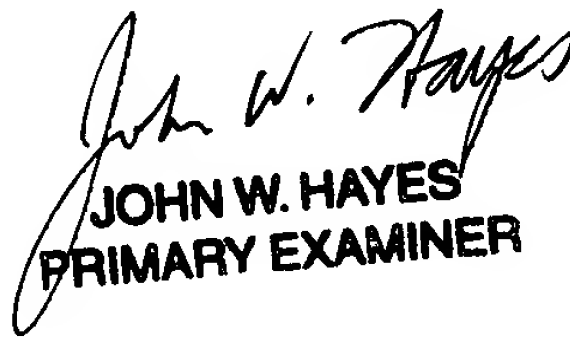
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
PO Box 1450
Alexandria, VA 22313-1450

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,
Arlington, V.A., Seventh floor receptionist.

November 20, 2003


JOHN W. HAYES
PRIMARY EXAMINER